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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,327	11/23/2001	Paul H. Morrill JR.	5525/003	2659

7590 10/16/2003

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EXAMINER
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MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/990,327

Applicant(s)  
Morrill, Jr.

Examiner  
James W. Myhre

Art Unit  
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 20, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-110 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 and 99-110 is/are allowed.
- 6) ☒ Claim(s) 9-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on August 20, 2003 has been considered but is ineffective to overcome the Hassett (5,805,082) reference.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassett (5,805,082).

Claims 9, 17, 20, 26, 29, 35, 38, 44, 47, 53, 54, 62, 65, 71, 74, 80, 83, 89, 92, and 98:

Hassett discloses a method for transferring funds between different accounts, comprising:

- a. Sending/receiving wireless device identification information transmitted by a wireless device (col 5, lines 23-26 and col 20, lines 40-42);
- b. Entering a function code (instruction code) which identifies the desired transaction (col 8, lines 54-67);

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- c. Authorizing the transaction (col 14, lines 65-67 and col 28, lines 12-33);
- d. Determining the accounts involved in the transaction (col 4, lines 20-27 and col 18, lines 38-39); and
- e. Processing and confirming the transaction (col 16, lines 33-36).

While Hassett discloses that the transaction being performed pertains to the collection of tolls for vehicles using a toll road, it is not explicitly disclosed that the transaction could be the transfer of funds to pay for parking fees, goods, services, or public transit fares or to check on the balance of the source account. Official Notice is taken that these types of transactions are among the multitude of well known transaction types involving transfer of funds from one account to another. Furthermore, the type of transaction being performed does not affect the method steps involved in transferring the funds. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the funds transferring method of Hassett in other types of transactions, such as parking fees, goods, service, public transit fare, or merely to check the account balance of the source account. One would have been motivated to use the method for other types of transactions in order to expand the utility of the transponder, especially in reference to the payment of parking fees since the transponder would not require removal from the vehicle (although Hassett does disclose that the transponder could be “housed in a compact, portable enclosure adapted for removable attachment to a dashboard surface or other convenient location within the vehicle” (col 16, lines 17-20)).

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Claims 10, 11, 18, 19, 27, 28, 36, 37, 45, 46, 55, 56, 63, 64, 72, 73, 81, 82, 90, and 91:

Hassett discloses a method for transferring funds between different accounts as in Claims 9, 17, 26, 35, 44, 54, 62, 71, 80, and 89 above, and further discloses that the funds amount is either a pre-set amount or a variable amount identified by the wireless device and sent to the central processing unit (col 14, lines 12-15).

Claims 12, 13, 21, 22, 30, 31, 39, 40, 48, 49, 57, 58, 66, 67, 75, 76, 84, 85, 93, and 94:

Hassett discloses a method for transferring funds between different accounts as in Claims 9, 20, 29, 38, 47, 54, 65, 74, 83, and 92 above, and further discloses that the source account is identified from the wireless identification information and the destination account is identified by the function code information (col 28, lines 12-33).

Claims 14-16, 23-25, 32-34, 41-43, 50-52, 59-61, 68-70, 77-79, 86-88, and 95-97:

Hassett discloses a method for transferring funds between different accounts as in Claims 9, 21, 31, 38, 47, 54, 66, 75, 83, and 92 above, and further discloses using a keypad of the wireless device to enter the information (col 15, line 61 - col 16, line 3).

***Allowable Subject Matter***

4. Claims 1-8 and 99-110 contain allowable subject matter.
5. The following is a statement of reasons for the indication of allowable subject matter:

Prior art was found which disclosed remotely transferring funds between different accounts using personal computers and telephones (Kight et al, 5,383,113)(Benton, 4,341,951)

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(Atalla, EP 131,906). However, prior art could not be located which identified the user's account and completed the desired transaction based on the identification number of the cellular phone (i.e. user identification information transmitted on the subchannel of a cellular phone or other wireless telecommunications device) which is automatically transmitted to the service provider upon activation of the phone.

*Response to Arguments*

6. Applicant's arguments filed August 20, 2003 have been fully considered but they are not persuasive.

A. The Applicant identifies three events (embodiments) in Hassett and argues that the wireless device in the first event does not take part in the transaction in the first or third events and that there are no accounts involved in the second event. The Examiner notes that in the second event, the money stored on the IVC which is being debited is an account. Likewise, the money is being credited to the toll operator's account. In the first and third events, the information transmitted by the IVC is used to complete a transaction. As the Applicant points out, the financial record created by the exchange of information between the IVC and the roadside equipment is used "to actually implement a financial transaction between two different accounts". The argument that transmitting data which triggers a transaction is not the same as taking part in the transaction is not persuasive. Using this line of reasoning, a person who pays for a purchase with a check is not taking part in the transaction because the two bank accounts involved transfer

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the money between themselves upon processing the check without the person having to physically carry the money from one to the other. The Examiner notes that there is a recognized difference between completing a transaction and the actual transference of the funds between accounts. Once the driver in Hassett has passed the toll collector and the toll has been deducted from the IVC or an account has been identified from which the money will be debited, the transaction part is complete. Only the electronic transfer of the money between the accounts needs to be done, which in some instances may be substantially immediately. This is the same as in the current claims where once the wireless device has transmitted its identity, the money is transferred between the identified accounts located at the financial institutions. Using the Applicant's logic, once the wireless device transmits its identity it no longer takes part in the transaction.

B. The Applicant's arguments in reference to Claim 9 are similar to the above argument, namely that Hassett does not disclose that the wireless device for funds transfer. Again, both the claim and the reference disclose the wireless device transmitting its identity to start the transfer of funds for the transaction. Furthermore, while the claims do not actually disclose transferring funds from an account on the wireless device, the reference does during the first event as identified by the Applicant. The reference explicitly discloses that the wireless device transmits its identity, not the identity of the vehicle in which it is located (see abstract, lines 8-10).

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C. The Applicant argues that Hassett does not disclose entering a function code on a keypad of the wireless device nor sending the function code to a central processor. The Examiner notes that Hassett discloses a keypad available at the wireless device upon which required data may be entered. When completing a transaction, such as a toll payment, information pertaining to the accounts involved, payment amount, vehicle identity (type), etc. could be required to be entered, depending on what information is already present within the wireless device and what information needed to be entered by the user. The reference explicitly discloses that the payment amount and other information, such as the wireless device identity is transmitted to the roadside receiver. Thus, Hassett discloses a function code, which is defined in Claim 9 as “which identifies the desired funds transfer”.

D. The Applicant also argues in reference to Claim 17 that the reference does not disclose the central processing unit authorizing and confirming the payment transaction (pages 8 and 9). The Examiner notes that Hassett explicitly discloses that the central processing unit receives the transaction information, compares the received balance and the toll paid with the last recorded balance for that account, and transmits an acknowledgment back to the remote device (col 28, line 52 - col 29, line 28). This section also discloses the central processing unit processing an automatic credit transaction to update the amount of money stored in an account on the remote device, sending a “Balance Incremented” notice back to the remote device, and updating the central account records (after processing the information with the authorized bank, credit card, or



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telephone billing account). Thus, Hassett explicitly discloses the central processing unit authorizing and confirming the payment transaction.

E. The Applicant presents the same above arguments with respect to Claims 26, 35, 54, 62, 71, 80, 89, and 98. The Examiner's responses above also pertain to these claims.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

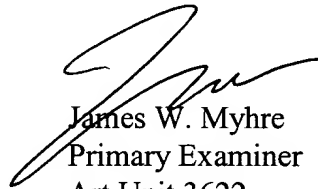
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM  
October 14, 2003



James W. Myhre  
Primary Examiner  
Art Unit 3622